

REMARKS

Status of Claims

Claims 1, 3-20, 30, 32-35, 43, and 44 are pending in this application. Reconsideration and allowance are respectfully requested in view of the following remarks.

Rejection under 35 U.S.C. §112

Claims 19-20 and 34-35 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention..

Claims 19-20 and 34-35 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

“The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. § 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.” MPEP § 608.01(n)(III) (2004).

Claims 19-20 and 34-35 are dependent claims that further define the claimed invention. These claims define the statutory classes under which the claimed invention may be categorized. “The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper.” *Id.* Claims 19-20 and 34-35 define computer-readable medium and system alternatives of the claimed invention. The Office Action alleges that it is not clear whether claims 19-20 and 34-35 are dependent claims. Claims 19-20 and 34-35 refer back to a base claim and further define the claimed invention. Therefore, claims 19-20 and 34-35 are proper dependent claims. Accordingly, withdrawal of the rejection is respectfully requested. Furthermore, MPEP

2173.05(f) provides guidance for interpreting claims which reference a preceding claim of a different statutory class to define claim limitations. Section 2173.05(f) cautions that these claims are acceptable claims and should not necessarily be rejected as improper or confusing.

Rejections under 35 U.S.C. §102

Claims 1, 3-6, 19-20, 30, 34-35, and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,745,880 to Strothmann.

With respect to independent claims 1, 30 and 44, Strothmann fails to disclose, among other things, identifying one or more services or resources utilized to execute the computer transaction, assigning a portion of the monetary service providing cost of each resource to the computer transactions, and summing the monetary service providing cost of each resource to determine the monetary cost for the computer transaction.

Strothmann discloses a system for estimating costs associated with running an application on a current system and an alternative system. U.S. Patent No. 5,745,880 (issued Oct. 3, 1994). Strothmann discloses calculating the cost of a generic computing function based on a total yearly cost calculated by totaling costs across three categories, hardware, software and facilities cost over a period of a year. Id. at col. 2, ll 55-col. 3, ll.15. Strothmann details the cost of a generic computing function is then determined by dividing the total cost by the total number of applications, which provides an average cost for the generic computing function. Id. at col. 3, ll. 10-30. The generic computing function is used to generate estimates for changes in the categories over a period of years. Id. at Table A. Furthermore, costs associated with an alternate computing environment

are estimated and a comparison between the current and alternate systems are made over a period of years. *Id.* at Tables B-P. Accordingly, Strothman discloses a system to evaluate movement of computer application functions from an existing computer to an alternate, wherein the generic computing function is used as a baseline for estimates of changes in cost over time.

Unlike Strothmann, embodiments of the invention calculate the actual cost for executing a computer transaction on a computer system currently utilizing one or more service and resources. The cost of executing the computer transaction on the current system includes cost of the current services and resources utilized to execute the computer transaction. The cost of executing the current computer transaction is not a generic cost related to the overall cost of the current system. Embodiments of the invention, provides a granular cost analysis that calculates service costs and resource costs, which are summed and passed on to the end user executing the computer transaction. The cost calculated by Strothmann is a generic, average, cost for executing a function on a computer system executing a certain number of applications. The cost of Strothmann does not having the granularity for defining a transaction cost as including one or more service and resource costs associated with a computer transaction executed by the user. Accordingly, for at least the reasons set forth above, the 35 U.S.C. § 102(b) rejection should be withdrawn and claims 1, 30 and 44 should be allowed over the prior art.

Dependent claims 3-6, 19-20 and 34-35 depend from claims 1 and 30 and further defines novel features of the claimed invention. Accordingly, for at least the reasons set

forth above, the 35 U.S.C. § 102(b) rejection should be withdrawn and claims 3-16, 19-20 and 34-35 should be allowed over the prior art by virtue of their dependence on claims 1, 30 and 44.

Rejections under 35 U.S.C. §103

Claim 43 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Strothmann. This rejection is respectfully traversed.

The Office states that the limitations of claim 43, which include “identifying a fixed cost resource and attributing a portion of a total monetary service providing cost for the fixed cost resource to the computer transaction, and identifying variable cost resources and determining a portion of the variable cost resources required to conduct the transaction, and summing a monetary service providing cost for the fixed cost resource and a monetary service providing cost for the variable cost resource to determine the monetary cost for the computer transaction,” are well-known in the art. Accordingly, applicants challenge this assertion and would like the Office to provide documentary evidence to support the conclusion that these limitations are well known. See MPEP 2144.03 (2004). The prior art fails to disclose determining fixed and variable costs related to executing the computer transaction. Strothmann discloses utilizing a generic function to estimate costs related to future costs and conversion costs of one or more applications to an alternate system over a period of time. Strothmann fails to teach or suggest, among other things identifying fixed and variable cost resources that are required to execute the computer transaction executed by the user. Moreover, Strothmann fails to disclose determining the portion of the fixed and variable costs that

are assignable to the computer transaction. Accordingly, for at least the reasons set forth above, the 35 U.S.C. § 103(a) rejection should be withdrawn and claim 43 should be allowed over the prior art.

Claims 7-18 and 32-33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Strothmann in view of Modeling Resources Allocation and Performance Measures in Distributed Computer Networks.

Claims 7, 18 and 32 are allowable because Modeling and Strothmann fails to disclose, among other things, “determining a cost for a level of quality of the one or more services utilized to execute the transaction.”

As indicated above Strothmann fails to disclose limitations of claims 1 and 30, such as, identifying one or more services or resources utilized to execute the computer transaction, assigning a portion of the monetary service providing cost of each resource to the computer transactions, and summing the monetary service providing cost of each resource to determine the monetary cost for the computer transaction. Accordingly, for at least the reasons above, claims 7, 18, and 32 are allowable over the prior art.

Moreover, claims 7, 18, and 32 define novel features of the claimed invention and are allowable because the prior art, including Modeling and Strothmann, fails to disclose a cost of a level of quality associated with a computer transaction executed by a user. The Office Action references FIGS. 1-4 and Tables 1-3 of Modeling as providing the deficiencies of Strothmann with respect to the costs for a level of quality. FIGS. 1-4 and Tables 1-3 refer to different optimal designs that are generated when non-decision variables and constraints relating to communication costs are varied. *Id.* §§ 4-5. A

network engineer using the modeling utility is able to determine the robustness of a network design when unforeseen events, such as increased query traffic or changed capacities and time delays, are introduced to the network by varying the non-decision variables. *Id.* The modeling utility applies the changed variables and constraints to the objective function (Z) and determines the overall cost for new optimal network designs. *Id.* § 2.3.

Modeling does not disclose determining a cost for a level of quality of the one or more services utilized to execute the transaction. Moreover, as indicated above, the modeling utility does not identify the underlying services utilized by a computer transaction. Therefore, the cost for a level of quality for one or more **services** is not determined by the modeling utility.

Unlike Modeling, embodiments of the invention, provide costs associated with executing a computer transaction initiated by the user. The cost of the user transaction include various considerations, such as, service costs, resource costs, and quality costs, which are related depending on the services utilized when executing the computer transaction. The cost analysis is a granular analysis of the costs associated with executing the computer transaction, which may be passed on to the user that initiated the computer transaction. Accordingly, for at least the reasons set forth above, claims 7, 18 and 32 are allowable over the prior art.

Dependent claims 8-17 and 33 depend from claims 7 and 32 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, the 35 U.S.C. § 103(a) rejection should be withdrawn and claims 8-17 and 33 should be allowed over the prior art by virtue of their dependence on claims 7 and 32.

In order to make out a prima facie case of obviousness, the references must provide all of the elements of the invention as claimed and a suggestion to combine the disclosures of the various cited art references to make the claimed invention. See, *In re Geiger*, 815 F.2d 686,688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

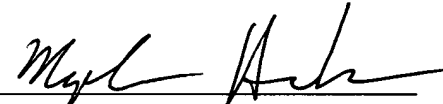
Here, Modeling and Strothmann fail to teach or suggest, among other things, identifying one or more services or resources utilized to execute the computer transaction, assigning a portion of the monetary service providing cost of each resource to the computer transactions, and summing the monetary service providing cost of each resource to determine the monetary cost for the computer transaction. Accordingly, for at least the reasons set forth above, claims 1, 3-20, 30, 32-35, 43, and 44 should be allowed over the prior art.

CONCLUSION

As set forth above, applicants respectfully submit that all pending claims are in condition for allowance. Applicants respectfully request that this application be allowed and passed to issue. Should, however, any issues remain prior to issuance of this application, the Examiner is urged to contact the undersigned to resolve the same. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.70154.

Respectfully submitted,

Date: September 22, 2005


Monplaisir Hamilton
Reg. No. 54,851

SHOOK, HARDY & BACON L.L.P.
600 14th Street, N.W.
Suite 800
Washington, DC 20005-2004
Phone: (202) 783-8400